

III. REMARKS

Applicants have considered the current Office Action with mailing date of December 7, 2006. Claims 1-20 are pending in this application. By this amendment, claims 1, 10, 14 and 18 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, claims 1, 14 and 18 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Claims 1-6, 9, 14-16 and 18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Pub. No. 2001/0051904A1 hereafter "Nishimura." Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura in view of US Pub. No. 2003/0182391A1, hereafter "Leber et. al.". Claims 10, 12-13, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being allegedly being unpatentable over Nishimura in view of US Pub. No. 2002/0154114A1, hereinafter "Christensen et. al.". Claim 11 is being rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura in view of Leber et. al. and Christensen et. al. Applicants respectfully disagree with the Office and present the following arguments for the Office's reconsideration.

A. REJECTION OF CLAIMS 1, 14 and 18 UNDER 35 U.S.C. §101

With respect to the rejection of claims under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter, Applicants have amended independent claims 1, 10, 14 and 18 to recite, *inter alia*, display/displaying “a custom data form using the computer ...”. Applicants submit that the functionality of the method/system/computer program product is realized, *inter alia*, through the interrelationship between display of a custom data form and the computer when managing custom data. Applicants believe that this amendment addresses the Office’s rejection based on non-indication of hardware in the body of the claims; and hence the claims are directed to statutory subject matter. Support for this amendment is found in [0020] and [00021] of the specification of the application. Accordingly, Applicants respectfully request that the Office withdraw this rejection and allow the claims.

In addition, with respect to currently amended claim 18, Applicants respectfully submit that “...the computer program product [embodied in] a computer readable medium...” is statutory subject matter. The claimed computer program product defines structural and functional interrelationships between the program codes comprised therein and the computer through which the computer program product is implemented. The defined structural and functional interrelationships permit the program codes’ functionality of managing custom data to be realized when implemented through the computer during an electronic purchase. (Annex IV on page 52 of Interim Guidelines for Examination of Patent Applications from Patent Subject Matter Eligibility.) Accordingly, Applicants respectfully request that the Office withdraw this rejection and allow the claim.

B. REJECTION OF CLAIMS 1 – 6, 9, 14 – 16 and 18 UNDER 35 U.S.C. §102(b)

With regards to the 35 U.S.C. §102(b) and §103(a) rejections of independent claims 1, 10, 14 and 18, over primary reference, Nishimura, secondary references Leber and Christensen, Applicants assert that Nishimura does not teach each and every feature of the claimed invention. Applicants respectfully re-iterate previously presented arguments and disagree with the Office's inference that "...specification type [in Nishimura]...could be item type ... [and] therefore it could be a key [in claimed invention]...". Page 14 of current Office Action. While page 10 of Applicants' previous response explained that attributes of an item may include, for example, item type, no explanation or representation indicating that attributes of an item is equivalent to a key/a set of keys was included. As explained on page 9 – 10 in the previous response, a key comprises an attribute with a corresponding value that matches the attribute comprised therein. Since a key comprises two distinct information components, it is not equivalent to an attribute per se and more specifically, not an item type. Therefore, Nishimura's specification type cannot be a key. As such, the Office's inference of Nishimura's teachings appears to be hindsight in view of the claimed invention, which is impermissible. Furthermore, the Office's assertion that specification type could be a key amounts to an Official Notice which is unsupported. Applicants respectfully request that the Office provides factual support of this assertion without which the withdrawal of this rejection is respectfully requested.

Assuming, *arguendo*, that Nishimura's specification type is equivalent to the claimed key, Applicants respectfully submit that Nishimura does not teach that "...each key is generated based on data collected on a custom data form...". Claim 1. Although Nishimura's retrieval of "...commodity having a combination of specification selected by the purchase applicant..." in [0094] appears to be comparing specification types with specification in the commodity data base [0065], Nishimura does not teach, *inter alia*, the claimed feature of "...comparing the set of

attributes to a set of keys, wherein each key is generated based on a data collected on a custom data form and wherein each key includes an attribute with a corresponding matching value ...”.

Claim 1. To this extent, Nishimura’s choices available for customization are not equivalent to keys in the claimed invention. As such, Nishimura does not anticipate the claimed invention. Accordingly, Applicants respectfully request that the Office withdraw the rejection and allow the independent claims.

C. REJECTION OF CLAIMS 7, 8, 10, 12 – 13, 17 and 19 – 20 UNDER 35 U.S.C. §103(a)

With respect to the Office’s rejection of the claims under 35 U.S.C. §103(a), Applicants submit that secondary references, Leber and Christensen do not cure the deficiencies of Nishimura. Applicants submit, in addition to previously presented arguments with respect to independent claims 1, 10, 14 and 18 that Leber and Christensen do not teach or suggest, *inter alia*, “...comparing the set of attributes to a set of keys...”. More specifically, Leber and Christensen do not teach or suggest that “...each key is generated based on data collected on a custom data form and wherein each key includes an attribute with a corresponding matching value...”. Claim 1.

The Office asserts on page 9 of current Office Action that Christensen cures the deficiencies of obtaining and storing custom data (page 5, [0049], lines 21 – 25 and lines 48 – 51) because Christensen’s “selected options” is equivalent to the claimed “input field”. Applicants respectfully disagree with this rationale of the Office. For example, Christensen’s “selected options” are a group of custom product items within a product hierarchy from which a user may exercise his choice. Page 5, [0049], lines 22 – 23. In contrast, the claimed input field is a means for collecting information on attributes of an item. As such, an item presented as a selected option cannot be equivalent to a means of collecting information on an item.

Furthermore, even assuming, *arguendo*, that Christensen successfully cures these acknowledged deficiencies of Nishimura, Christensen still does not cure Nishimura's deficiency in "...comparing the set of attributes to a set of keys ..." because Christensen does not teach or suggest, *inter alia*, that each key with an attribute and a corresponding value is generated based on data collected on a custom data form. Claim 1. To this extent, a person of ordinary skill would not even find any motivation to look to Christensen since it does not provide a likelihood of successfully leading to the claimed invention by combining with Nishimura. As such, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the Office withdraw this rejection and allow the independent claims.

In the same vein, the Office's assertion that Leber's concatenation cures Nishimura's limitation does not render the claimed invention as being obvious because Leber also does not cure Nishimura's deficiency of "...comparing the set of attributes to a set of keys, wherein each key is generated based on data collected on a custom data form and wherein each key includes an attribute with a corresponding matching value...". Claim 1. As such, a person of ordinary skill would not consider Leber's concatenation methods when a fundamental feature of the claimed invention is not taught by Nishimura. Hence, Applicants respectfully request that the Office withdraw the rejection and allow dependent claims 7 and 8.

Following from the above, Applicants submit that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03. Since the primary reference has a multitude of deficiencies, which when modified according to teachings of the secondary references, does not teach the claimed feature of having keys generated base on data collected on a custom data form and which also includes attributes with corresponding matching values, a person of ordinary skill would find no motivation to modify or combine the references. As such, a *prima facie* case of obviousness has

not been established. Accordingly, Applicants respectfully request that the Office withdraw the rejections and allow the independent claims.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of all the rejections.

IV. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique feature. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



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